

**REMARKS**

**Claim Rejections**

Claims 1, 2, 4-8, 10-16, 19, 21, and 22 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Boer et al. (US Pub. 2004/0101035) in view of Girardeau et al. (US 7,099,398). Claims 3, 17, 18, and 23-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Boer et al. in view of Girardeau et al. and further in view of Srikrishna et al. (US Pub. 2005/0129005). Claims 9 and 20 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Boer et al. in view of Girardeau et al. and further in view of Adachi (US Pub 2001/0022806).

**Drawings**

It is noted that the Examiner previously accepted the drawings as originally filed with this application.

**Claim Amendments**

By this Amendment, Applicant has canceled claims 2, 3, 16, 17, and 23-26 and amended claims 1 and 11 of this application. It is believed that the amended claims specifically set forth each element of Applicant's invention in full compliance with 35 U.S.C. § 112, and define subject matter that is patentably distinguishable over the cited prior art, taken individually or in combination.

On page 10 of the outstanding Office Action, the Examiner admits that "Boer et al as modified by Girardeau et al show the method of claim 2, but fail to specifically show that the state parameter is a ratio determined by dividing the number of received packets with the number of transmitted packets."

Applicant traverses the rejection of claims 3, 17, 18, and 23-26 as being unpatentable over Boer et al. in view of Girardeau et al. and further in view of Srikrishna et al. (US Pub. 2005/0129005). Srikrishna et al. is not "prior art" under any section of 35 U.S.C. §102 with respect to the instant application. 35 U.S.C. §102 (e)(1) requires that a published application be by another filed in the United States before the invention by the Applicant for a patent. Applicant notes that the published application to Srikrishna et al. was not filed in the United States until June 24, 2003, a date that is subsequent to the Applicant's date of invention on the record

of this application, which is Applicant's priority date of February 26, 2003. Srikrishna et al., which is a continuation-in-part of Chari et al. (US Pub. 2004/0008663, Application No. 10/602,439), teaches the ratio formula. However, there is no suggestion of the ratio formula in the parent Application No. 09/751,262 (US 6,704,301) to Chari et al. Therefore, the subject matter of the ratio formula was new subject matter added in the continuation-in-part to Srikrishna et al. Since Srikrishna et al. (US Pub. 2004/0008663) was not filed until June 24, 2003, which is subsequent to the priority date of February 26, 2003 of the present application, Srikrishna et al. is not prior art with respect to the present application. The outstanding rejection of claims 3, 17, 18, and 23-26 as being unpatentable over Boer et al. in view of Girardeau et al. and further in view of Srikrishna et al. (US Pub. 2005/0129005) is respectfully traversed.

Adachi does not teach the state parameter is a ratio determined by dividing the number of the received packets with the number of the transmitted packets, nor does Adachi teach the first state parameter is a ratio determined by dividing a number of the first received packets with a number of the first transmitted packets.

Even if the teachings of Boer et al., Girardeau et al., and Adachi were combined, as suggested by the Examiner, the resultant combination does not suggest: the state parameter is a ratio determined by dividing the number of the received packets with the number of the transmitted packets; nor does the combination suggest the first state parameter is a ratio determined by dividing a number of the first received packets with a number of the first transmitted packets.

It is a basic principle of U.S. patent law that it is improper to arbitrarily pick and choose prior art patents and combine selected portions of the selected patents on the basis of Applicant's disclosure to create a hypothetical combination which allegedly renders a claim obvious, unless there is some direction in the selected prior art patents to combine the selected teachings in a manner so as to negate the patentability of the claimed subject matter. This principle was enunciated over 40 years ago by the Court of Customs and Patent Appeals in In re Rothermel and Waddell, 125 USPQ 328 (CCPA 1960) wherein the court stated, at page 331:

The examiner and the board in rejecting the appealed claims did so by what appears to us to be a

piecemeal reconstruction of the prior art patents in the light of appellants' disclosure. ... It is easy now to attribute to this prior art the knowledge which was first made available by appellants and then to assume that it would have been obvious to one having the ordinary skill in the art to make these suggested reconstructions. While such a reconstruction of the art may be an alluring way to rationalize a rejection of the claims, it is not the type of rejection which the statute authorizes.

The same conclusion was later reached by the Court of Appeals for the Federal Circuit in Orthopedic Equipment Company Inc. v. United States, 217 USPQ 193 (Fed.Cir. 1983). In that decision, the court stated, at page 199:

As has been previously explained, the available art shows each of the elements of the claims in suit. Armed with this information, would it then be non-obvious to this person of ordinary skill in the art to coordinate these elements in the same manner as the claims in suit? The difficulty which attaches to all honest attempts to answer this question can be attributed to the strong temptation to rely on hindsight while undertaking this evaluation. It is wrong to use the patent in suit as a guide through the maze of prior art references, combining the right references in the right way so as to achieve the result of the claims in suit. Monday morning quarterbacking is quite improper when resolving the question of non-obviousness in a court of law.

In In re Geiger, 2 USPQ2d, 1276 (Fed.Cir. 1987) the court stated, at page 1278:

We agree with appellant that the PTO has failed to establish a *prima facie* case of obviousness. Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching suggestion or incentive supporting the combination.

Applicant submits that there is not the slightest suggestion in either Boer et al., Girardeau et al., Srikrishna et al., or Adachi that their respective teachings may be combined as suggested by the Examiner. Case law is clear that, absent any such teaching or suggestion in the prior art, such a combination cannot be made under 35 U.S.C. § 103.

Neither Boer et al., Girardeau et al., Srikrishna et al., nor Adachi disclose, or suggest a modification of their specifically disclosed structures that would lead one having ordinary skill in the art to arrive at Applicant's claimed structure. Applicant hereby respectfully submits that no combination of the cited prior art renders obvious Applicant's amended claims.

### **Summary**

In view of the foregoing, Applicant submits that this application is now in condition for allowance and such action is respectfully requested. Should the Examiner not be of the opinion that this case is in condition for allowance, it is requested that this amendment be entered for the purposes of appeal, since it materially reduces the issues on appeal by cancelling claims 2, 3, 16, 17, and 23-26, thereby rendering moot the outstanding rejections under 35 U.S.C. § 103.

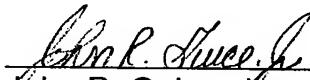
It is not believed that the foregoing amendments to claims 1 and 11 require any further searching and/or consideration on the part of the Examiner, since such amendment merely includes incorporating the language of canceled claims 2 and 3 into claim 1 and claims 16 and 17 into claim 11. Thus, the Examiner would have inherently searched this subject matter during the previous consideration of claims 2, 3, 16, and 17.

Should any points remain in issue, which the Examiner feels could best be resolved by either a personal or a telephone interview, it is urged that Applicant's local attorney be contacted at the exchange listed below.

Respectfully submitted,

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